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EXAMINER

MUSSER, BARBARA J

ART UNIT

PAPER NUMBER

1733

5

DATE MAILED: 07/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,331

Applicant(s)

HONIG, ERHARD

Examiner

Barbara J. Musser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 12-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, drawn to an apparatus for applying a plastic edge strip, classified in class 156, subclass 500.
- II. Claims 12-21, drawn to a method of applying a plastic edge strip, classified in class 156, subclass 244.11.
- III. Claim 22, drawn to a workpiece, classified in class 428, subclass 119.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can practice a different method such as applying the plastic strip to a the center on a planar surface.

3. Inventions I and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product can be made by a different apparatus such as cutting it to shape and applying it to the workpiece.

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4. Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a different process such as such as extruding the strip into a formed mold, removing it, heating it, and applying it to the workpiece.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Marvin Berkowitz on 5/29/03 a provisional election was made with traverse to prosecute the invention of group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Priority

7. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in South Africa on 7/8/99. It is noted, however, that applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b). A copy of the priority documents dated 3/10/99 has been received.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 8 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, it is unclear what is meant by "in front of".

Claim 11 recites the limitation "the transporting means" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Objections

10. Claim 10 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to the claims from which it depends in the alternative, i.e. "or". See MPEP § 608.01(n). Accordingly, the claim 10 has not been further treated on the merits.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 2, 5, 8, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ecklund et al.(U.S. Patent 3,239,402).

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Ecklund et al. discloses a device for applying a strip of thermoplastic to the edge of a workpiece using an extruder and a forming means which presses the strip of material against the edge of the workpiece.(Figure 1; Col. 2, ll. 23-31) While the claims include a plate-like workpiece, this is not a limitation on the apparatus. The apparatus of Ecklund et al. is capable of applying the strip to the edge of a plate-like workpiece recited in claim 1.

Regarding claims 2 and 11, the workpiece is transported past the extruder using a pair of driven rollers which contact the work.(11)

Regarding claim 5, rollers press against the work, ensuring it is flat.(11)

Regarding claim 8, the rollers(35) can be internally cooled.(Col. 4, ll. 44-46) This would cool the strip.

13. Claims 1, 5, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Munro(U.S Patent 4,597,821).

Munro discloses an apparatus for applying a strip to the edge of a workpiece using a device which extrudes adhesive onto the edge of the workpiece. A strip of material is applied thereto and a roller(66, 98) conforms the strip and adhesive to the shape of the workpiece.(Col. 1, ll. 6-14; Col. 2, ll. 58-67; Col. 7, ll. 28-33)

Regarding claim 5, while the claimed profile is not required to have a shape other than flat, it is noted that the edge of the workpiece can be curved,(Col. 7, ll. 38-41 and thus it is taken that the roller would also be curved, having the desired profile.

14. Claims 1, 2, 5, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakata et al.(U.S. Patent 5,693,174).

Nakata et al. discloses an apparatus for applying strip of material to the edge of a workpiece. The material deformed into a desired shape using a pressing means.(Figure 7; Col. 6, ll. 25-29, 45-53) The apparatus is capable of applying the strip to the edge of a plate-like workpiece recited in claim 1.

Regarding claim 2, a robotic arm moves the workpiece past the extruder.(Figure 7)

Regarding claim 7, primer can be applied to the window edge prior to application of the strip of material.(Col. 6, ll. 48-50).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munro.

Munro does not specifically disclose support means for the workpiece which clamp the workpiece to the support means. However, the reference does disclose that the device is intended to be movable about the workpiece and that the workpiece is placed on a table.(Abstract, Col. 7, ll. 67- Col. 8, ll. 3) It would have been obvious to one of ordinary skill in the art at the time the invention was made to clamp the workpiece to the table to prevent it moving while applying the edge strip.

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Regarding claim 4, while the reference discloses pressing the forming means against the workpiece, one in the art would readily appreciate that an obvious alternative would be to press the workpiece against the forming means. Only the expected results would be achieved.

17. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munro in view of Dorus(DE 29817408U1).

Munro does not disclose using several rollers with different profiles to deform the strand to the desired profile. It does, however, disclose that the strand can be applied to a curved surface such as a wood panel.(Col. 1, ll. 17-21; Col. 7, ll. 36-40). Dorus discloses an apparatus for applying a strip of material to a curved surface such as a wood panel wherein several pressure members have different profiles so that the strip can be shaped to the desired profile without being destroyed.(Abstract) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use several pressure members having varying profiles to shape the strip to the edge of the workpiece since this would shape it more easily to a curved surface and would reduce the amount of waste.(Abstract) While the reference does not specifically disclose the pressure members are rollers, one in the art would appreciate this would allow pressing without causing friction and heat buildup in the pressing members.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Barbara J. Musser** whose telephone number is (703)-

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305-1352. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



BJM
June 30, 2003



SAM CHUAN YAO
PRIMARY EXAMINER